

Application No.: 10/760,979
Filing Date: January 20, 2004
Page: 5

REMARKS

Claims 1 through 8, 10 through 15 and 17 through 20 are pending in the application.

Claim 1 has been amended to reflect particularly advantageous inventive films in which the overlayer (A) is formed from a single polyester consisting essentially of (i) at least one dicarboxylic acid; (ii) at least one aliphatic, cycloaliphatic or aromatic diol and (iii) from 4 to 30 mol % of isophthalic acid units. Support for this amendment can be found in the Application-as-filed, for example on Page 20, line 19 through Page 23, line 29.

Claim 4 has been amended to reflect advantageous embodiments of the invention in which the polyester present in the overlayer (A) contains from 6 to 28 mol % of isophthalic acid units and the resulting film exhibits a transparency of greater than 84 %. Support for this amendment can be found in the Application-as-filed, for example on Page 11, lines 17 through 19.

Claim 7 has been amended to conform to the scope of Claim 1. Support for this amendment can be found in the Application-as-filed.

Reexamination and reconsideration of this application, withdrawal of all rejections, and formal notification of the allowability of the pending claims are earnestly solicited in light of the remarks which follow.

Claim Rejections - 35 USC § 112

Claim 7 stands rejected over the transition phrase "comprising." Claim 7 has been amended to conform to Claim 1. In particular, Claim 7 has been amended to recite the transition phrase "consists essentially of."

Accordingly, Applicants request withdrawal of this rejection.

Application No.: 10/760,979
Filing Date: January 20, 2004
Page: 6

The Claimed Invention is Patentable
in Light of the Art of Record

Claims 1 through 8, 10 through 15 and 17 through 20 stand rejected over United States Published Application No. 2002/0071945 (US 945) or US 2002/0068158 (US 158); or US 2002/0068159 (US 159); or European Patent Applications 1 197 328 (EP 328); or 1 197 327 (EP 327); or 1 197 326 (EP 326) in view of United States Patent No. 4,818,581 (US 581) to Katoh et al.

Applicants respectfully submit that EP 328 is the European equivalent of US 945; EP 327 is the European equivalent of US 158 and EP 326 is the European equivalent of US 159. Consequently, distinguishing remarks directed to US 945 are intended to distinguish EP 328, as well. Remarks distinguishing US 158 and US 159 are likewise intended to distinguish EP 327 and EP 326, respectively. In addition, US 945, US 158 and US 129 may cumulatively be referred to hereinafter as "the Peiffer references."

It may be useful to briefly consider the invention before addressing the merits of the rejection.

The packaging industry has a need for films providing a number of challenging properties, including having a high degree of mattness, good transparency and low opacity. Applicants have determined a particular particle system, a multi-layered film configuration and polymer constitution that imparts a highly advantageous and heretofore unknown balance of mattness, good transparency, low opacity and low volume opacity to the resulting film. In particular, Applicants have determined that the inclusion of isophthalic acid within polyester matt outer layers incorporating a particular pigment system imparts a highly beneficial balance of properties, including improved transparency. (The Examiner's attention is kindly directed to the Application-as-filed on Page 22, line 11 through Page 23, line 7, Example 2 in comparison to Example 3).

Application No.: 10/760,979
Filing Date: January 20, 2004
Page: 7

Consequently, the claims are directed to polyester films having at least one base layer (B) and at least one matt overlayer (A). The overlayer (A) includes particles that have a median particle diameter d_{50} of from 2 to 10 μm and a SPAN98 smaller than or equal to 2. The overlayer (A) is formed from a single polyester that consists essentially of (i) at least one dicarboxylic acid; (ii) at least one aliphatic, cycloaliphatic or aromatic diol and (ii) from 4 to 30 mol % of isophthalic acid units. The inventive films exhibit a transparency of greater than 80 %.

In particularly advantageous embodiments, the overlayer (A) contains from 6 to 28 mol % of isophthalic acid units, and the resulting film exhibits a transparency of greater than 84 %, as recited in Claim 4.

The cited references do not teach or suggest the claimed invention.

Both US 945 and US 158 are directed to multi-layered polyester packaging films having a matt outer layer. US 159 is directed to mono-layered matt packaging films.

As noted by the Examiner, each of the Peiffer references broadly remarks that their films provide either "good" or "high" transparency. (US 945, Paragraph 0012; US 945, Paragraph 0018; US 945, Paragraph 0075; US 158, Paragraph 0015; US 158, Paragraph 0067; and US 159, Paragraph 0053). The Peiffer references are altogether silent, however, as to any quantitative transparency values associated with their films.

US 945 and US 158 generically disclose that their polymer may include ethylene isophthalate, in unspecified amounts for unspecified reasons. (US 945; Paragraph 0024 and US 158, Paragraph 0025). The ethylene isophthalate is included in a generic list that further provides ethylene terephthalate and ethylene 2,6-naphthalate as equivalent alternatives. US 159 is altogether silent as to the inclusion of ethylene isophthalate, although specifically enumerating a number of other suitable polyesters. (US 159, Paragraph 0014).

Application No.: 10/760,979
Filing Date: January 20, 2004
Page: 8

Each of the Peiffer references does specifically teach a polymeric component that is touted to provide improved transparency. In fact, the polymeric component is of such prominence in the Peiffer references that it has its own name, i.e. "Component I." Component I includes sulfomonomer amongst its required ingredients. (US 945; Paragraphs 0032 – 0036; US 158, Paragraphs 0036 – 0040 and US 159, Paragraphs 0028 - 0033). Each of the Peiffer references incorporates Component I into one of its working examples. (US 945; Paragraphs 0115 – 0118; US 158, Paragraph 0111 – 0115 and US 159, Paragraph 0100 - 0107). As alluded to above, each of the Peiffer references then goes on to expressly teach that the sulfomonomer-containing Component I imparts improved transparency. (US 945; Paragraph 0119; US 158, Paragraph 0114 and US 159, Paragraph 0103).

Accordingly, Applicants respectfully submit that the Peiffer references do not teach or suggest that films advantageously including an overlayer (A) formed from a single polyester that consists essentially of 4 to 30 mol % of isophthalic acid, dicarboxylic acid and diol would result in a transparency of greater than 80 %. The Peiffer references instead teach away from such embodiments by expressly recommending the incorporation of sulfomonomer to improve transparency.

And the Peiffer references most certainly do not teach or suggest that such films including an overlayer (A) containing from 6 to 28 mol % of isophthalic acid units would result in a film exhibiting a transparency of greater than 84 %, as recited in Claim 4.

Applicants thus respectfully submit that Claims 1 through 8, 10 through 15 and 17 through 20 are patentable in light of the Peiffer references, considered either alone or in combination with the art of record.

US 581 does not cure the deficiencies in the Peiffer references.

Application No.: 10/760,979
Filing Date: January 20, 2004
Page: 9

US 581 is directed to mono-layered magnetic tapes incorporating spherical silica to improve drop out properties. The magnetic tapes are formed from polyester derived from any of a laundry list of apparently equivalent di-carboxylic acids, including anthracene dicarboxylic acid. (Col. 3, lines 49 – 55). In addition to the main acid component, the polyester may further include a maximum of 20 mole % of an additional, unspecified acid. (Col. 4, lines 2 – 6). The working examples are formed from polyethylene terephthalate alone, however. (Col. 15, line 20 – Col. 29, line 20). US 581 broadly notes that its films may exhibit “high transparency.” (Col. 10, lines 32 – 34). US 581 is likewise silent as to any quantitative value for such transparency; however.

Applicants respectfully submit that US 581, directed to mono-layered films, does not teach or suggest the recited multi-layered films, much less such multi-layered films advantageously including an overlayer (A) formed from a single polyester that consists essentially of 4 to 30 mol % of isophthalic acid, dicarboxylic acid and diol..

And US 581, altogether silent as to the quantitative transparency of its films, most certainly does not teach or suggest that such advantageous films would further exhibit a transparency of greater than 80 %.

Nor does US 581 teach or suggest that such films including an overlayer (A) containing from 6 to 28 mol % of isophthalic acid units would result in a film exhibiting a transparency of greater than 84 %, as recited in Claim 4.

Accordingly, Applicants respectfully submit that Claims 1 through 8, 10 through 15 and 17 through 20 are patentable in light of US 581, considered either alone or in combination with the art of record.

There would have been no motivation to have combined the Peiffer references and US 581. Applicants respectfully reiterate that merely because the references can be combined is not enough, there must still be a suggestion. MPEP 2143.01 (section citing Mills). The Peiffer

Application No.: 10/760,979
Filing Date: January 20, 2004
Page: 10

references are each directed to packaging films having a matt appearance. US 581 is directed to magnetic tapes having improved drop-out properties. These are altogether different fields of endeavor and problems solved, to say the least.

Applicants respectfully reiterate that polyester films suitable for one application will not automatically work in another application, as each application has its own unique requirements. Therefore, a film for one application may not suggest a solution for another application.

Applicants further respectfully reiterate that the Office Action is instead indulging in impermissible hindsight by merely picking and choosing elements from the prior art while using the instant specification as the guide for that selection process.

The Office Action indicates that the Peiffer references are "capable of" high transparency. Applicants respectfully submit that the test for obviousness is instead whether or not the reference teachings are sufficient for one of ordinary skill in the art to make the proposed combination or modification. *In re Linter*, 458 F.2d at 1016, 173 USPQ 560 (CCPA 1972).¹ Furthermore, the references must be considered as a whole. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 220 USPQ 303 (Fed. Cir. 1983).

Applicants respectfully submit that none of the cited references teach or suggest the recited multi-layered films including an overlayer (A) formed from a single polyester that consists essentially of 4 to 30 mol % of isophthalic acid, dicarboxylic acid and diol, much less that such films would further exhibit a transparency of greater than 80 %.

The primary references clearly teach instead that transparency may be improved by including a sulfomonomer.² Thus there would have been no reasonable expectation of success,

¹ Applicants respectfully make of record that the test for patentability is not whether the references are "capable" of achieving a recited property, i.e. a transparency value of 80 or more. The test is instead whether the references, considered as a whole, teach or suggest that the combination of recited elements would produce the recited property.

² The Office Action correctly indicates that sulfomonomer is not required for all of the films of Peiffer. Applicants respectfully submit, however, that the Peiffer references do expressly require sulfomonomer within films having "improved" transparency.

Application No.: 10/760,979
Filing Date: January 20, 2004
Page: 11

i.e. the provision of a transparency of greater than 80%, from the recited incorporation of a single polyester that consists essentially of isophthalic acid, dicarboxylic acid and diol.

Consequently, even if combined (which Applicants reiterate should not be done), the claimed invention would not result.

In particular, the combination of the Peiffer references and US 581 would not result in the recited films incorporating a particle system having a diameter of from 2 to 10 μm and a maximum SPAN98 of 2, much less such films including an overlayer (A) formed from a single polyester that consists essentially of 4 to 30 mol % of isophthalic acid, dicarboxylic acid and diol, resulting in a transparency of greater than 80 %.

And the combination most certainly does not teach or suggest such films including an overlayer (A) containing from 6 to 28 mol % of isophthalic acid units, resulting in a transparency of greater than 84 %, as recited in Claim 4.

Accordingly, Applicants respectfully submit that Claims 1 through 8, 10 through 15 and 17 through 20 are patentable in light of the Peiffer references and US 581, considered either alone or in combination.

Consideration of Previously Submitted Information Disclosure Statement

It is noted that an initialed copy of the PTO/SB/08A that was submitted with Applicants' Information Disclosure Statement filed January 20, 2004 has not been returned to Applicants' representative with the Office Action. Accordingly, it is requested that an initialed copy of the PTO/SB/08A form be forwarded to the undersigned with the next communication from the PTO. In order to facilitate review of the references by the Examiner, a copy of the Information Disclosure Statement and the PTO/SB/08A form are attached hereto. Copies of the cited references were provided at the time of filing the original Information Disclosure Statement, and, therefore, no additional copies of the references are submitted herewith. Applicants will be pleased to provide additional copies of the references upon the Examiner's request if it proves

Application No.: 10/760,979
Filing Date: January 20, 2004
Page: 12

difficult to locate the original references.

CONCLUSION

It is respectfully submitted that Applicants have made a significant and important contribution to the art, which is neither disclosed nor suggested in the art. It is believed that all of pending Claims 1 through 8, 10 through 15 and 17 through 20 are now in condition for immediate allowance. It is requested that the Examiner telephone the undersigned if any questions remain to expedite examination of this application.

It is not believed that extensions of time or fees are required, beyond those which may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time and/or fees are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR § 1.136(a), and any fee required is hereby authorized to be charged to Deposit Account No. 50-2193.

Respectfully submitted,

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